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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/804,900	02/24/1997	ROBERT MECHALEY JR.	06318/005001	1485

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EXAMINER
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POINVIL, FRANTZY

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 04/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/804,900

Applicant(s)

MECHALEY ET AL.

Examiner

Frantzy Poinvil

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Wk

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |                                                                                                                                         |                                                                                         |
|-----------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                             | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>31</u> . | 6) <input type="checkbox"/> Other: _____                                                |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abelow (US Patent No. 5,999,908) in view of Cooper (US Patent No. 5,499,295).

Applicant's representative argues that Abelow solely teaches a way to assist product development and to "accelerate future improvements in the product by means of customer-generated suggestions" and cites column 12, lines 44-46, column 8, lines 36-37 stating "in the design and evolution of products and services". Applicant further states that "Abelow's method is given as an alternative to development through 'market research' " citing column 6, lines 56-58 of Abelow.

The Examiner notes that Abelow does provide those teachings and applicant's citation supporting applicant's assertion is well placed. However, the applicant should also note that the cited passages are one of many embodiments disclosed in Abelow. Applicant made no comments relating to the passages cited by the Examiner with respect to Abelow's teaching of their claimed features. On column 10, line 15 to column 12, line 54 and column 18, lines 1-62 of Abelow, it is stated:

“[T]he module being attached to a product or service includes means for storing and collecting a customer’s usage of the product and transmits collected data to a remote vendor using a transmission medium. The module also includes entry means and voice and speaker means for interacting with the consumer” (see column 10, line 50 to column 11, line 8). On column 10, lines 10-15, it is stated “**Built-in electronic mail lets them receive additional on-line services from those professionals 772, 726, 734 (such as validation of a product’s set of dialogs) or buy additional services and data from them**”. The module also analyzes user’s interaction with a product during a customer’s usage of the product. See column 9, lines 38-40 where it is stated “The CB-PD Module 670 obtains its findings while customers are in the middle of product uses 668, during their real situations and needs” and column 17, line 52 to column 18, line 37 and column 19, line 28 to column 20, line 27 where Abelow teaches a vendor may “Deliver dynamic product improvements through on-line communications built into the product, to upgrade existing products in the field while they are in the hands of customers”.

Applicant has amended independent claims 1 and 12 to recite “providing a computer system that includes a software product that initially provides to the user a subset of software product functionality from a set of available functions”. As per this feature, it is noted that the software or products that users of the Abelow system includes a subset of software functionality from a set of available functions since users are using the software or product into which the module is installed and the system of Abelow provides users with additional features being delivered to them immediately upon request (column 20, lines 6-9) and the system provides users the opportunity to purchase on-line additional services and data (column 10, lines 10-15 of Abelow). Abelow also teaches the claimed “collecting data describing user interaction with the

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subset of software product functionality” by collecting usage data of a product or software (see column 19, line 20 to column 20, line 30 of Abelow).

Abelow further teaches the step or function of “analyzing said data to determine whether at least one data pattern has been identified”. See column 45, lines 39-49, column 19, lines 14-16 and column 17, line 43 to column 18, line 20.

The step of “initiating, by the computer system, communication with the user of an availability of product functionality that can be perceived by the user and that is within the set of available functions, but not within the subset of software product functionality when said at least one data has been identified” would have been obvious to the skilled artisan because on column 10, lines 10-14 of Abelow teaches “**Built-in electronic mail lets them receive additional on-line services from those professionals 772, 726, 734 (such as validation of a product’s set of dialogs) or buy additional services and data from them**”. Whether the “on-line services are a subset of available functions” is not explicitly stated. Such would have been obvious to the skilled artisan because the additional on-line services relate to the software or product or service the user of the Abelow’s system is currently using.

In any event, Cooper teaches a method and apparatus for feature authorization and software copy protection in a unit of RF communication devices. See the abstract. Cooper also discloses providing a user with product having all necessary basic utilities as well as coded additional features that can be activated by a remote vendor or a customer upon request or for upgrading purposes. Applicant is directed to (column 7, lines 32-47; column 8, lines 20-51 and column 9, lines 34-67 of Cooper).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Cooper into Abelow in order to communicate to a product user, an availability of product functionality that can be perceived by the user and that is within the set of available functions, but not within the subset of software product functionality when said at least one data has been identified. The motivation would have been to provide the product user the ease of upgrading a particular product or software instantly or immediately as desired.

As per claims 2 and 23, note column 32, lines 1-49 of Abelow.

As per claim 3, note column 56, line 30 to column 57, line 39 of Abelow.

As per claims 4 and 5, collecting demographic data and geographical data would have been obvious to one of ordinary skill in the art in the combination of Abelow and Cooper as Abelow teaches providing the system in different remote locations. See column 19, lines 39-49 and column 37, lines 23-44 of Abelow. Such would have been obvious to one of ordinary skill in the art to provide in the combination of Abelow and Cooper for market analysis purposes.

As per claims 6 and 13, the number of times a software product is used, whether the software product is in use in a network environment and by a number of users are considered as threshold that would have been obvious to one of ordinary skill in the art to incorporate in the

combined system of Abelow and Cooper especially if a user needs additional usage time, or if it is detected attempts that the software product is to be used by a number of users or within a network environment, thus requiring the users to upgrade their system or be faced with penalties or with violations of usage terms and agreements of the software product. As per features regarding usage patterns, note column 45, lines 39-49 of Abelow.

As per claim 7, the teachings of Abelow and Cooper are discussed above. Abelow and Cooper fail to explicitly teach applying a fuzzy algorithm to the collected data to determine whether a said data pattern can be identified. However, the Examiner notes that fuzzy algorithm is routinely used for statistical analysis purposes. Using fuzzy algorithm in the system of Abelow and Cooper would have been obvious to one of ordinary skill in the art in order for vendors of the products to obtain a more accurate detailed analysis on the usage of their products for marketing purposes.

As per claims 8-10, note column 31, lines 40-60, column 11, and column 21, lines 30-61 and column 24, lines 52-59 of Abelow.

As per claims 11 and 14, Abelow discloses satisfying individual and groups and market needs. Thus, collecting information from a group of individuals would have been obvious to the skilled artisan in view of these teachings. Furthermore, Abelow respond to users based on data collected and based their responses and decisions regarding product usage and needs. See column 61, lines 58-65, column 19, line 20 to column 20, line 31. Cooper also discloses

providing software or service upgrading to users based on their needs or response. See column 7, line 34 to column 8, line 51 of Cooper

As per claim 15, note the rejection of claim 1 above regarding making an offer to the user for greater functionality in using the system.

As per claim 16, note the rejection of claim 1 above regarding making an offer to the user for greater functionality in using the system. Email and telephone or direct link with the customer are used for interacting with the user.

As per claim 17, offering greater functionality by the system to the user in multiple steps dependent at least upon the data patterns would have been obvious to one of ordinary skill in the art to introduce in the combination of Abelow and Cooper depending on what the user needs at a particular time.

Claim 18 contains features recited in claim 1 and these features are likewise rejected under a similar rationale. Claim 18 recites specific features such as analyzing to determine whether at least one use threshold has been satisfied and initiating by the computer system, communication....when said at least one threshold has been satisfied.

In response, the Examiner notes that a software product is usually sold to be used for a number of users, within a network or for a time limit. Thus these variables are use threshold. The user may need additional usage authorization if these threshold have been satisfied.



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Communicating with the user an availability of product functionality that can be perceived by the user and that is within the set of available functions but not within the subset of software product functionality when said at least one threshold has been satisfied” would have been obvious to do in the combination of Abelow and Cooper especially if a user needs additional usage time, or if it is detected attempts that the software product is to be used by a number of users or within a network environment, thus requiring the users to upgrade their system or be faced with penalties or with violations of usage terms and agreements of the software product.

As per claims 19-20, 23-24 and 26-27, Abelow teaches collecting interval of use data for the product (note column 37, lines 23-50, 45, lines 39-49 and column 32, lines 8-29 of Abelow) and statistical data regarding use of the product (column 56, line 30 to column 57, line 39 of Abelow).

Claim 21 contains features recited in claim 18 and these features are rejected under a similar rationale. As per features directing to a voice response personal assistant, the Examiner asserts that upgrading of software products may be via the telephone and/or from a remote vendor using a voice response telephone personal assistant system. See column 31, lines 40-60 and column 19, lines 39-49 of Abelow

Claims 22 and 25 are apparatus claims containing features recited in claim 1. Abelow and Cooper are computerized systems comprising means to perform the recited functions noted above. Thus, claim 22 is recited under a similar rationale applied to claim 1 above.

As per claims 28-30, Abelow does not explicitly teach step or means for indicating a selection of at a portion of the product functionality not within the subset of functionality of a software product. Cooper discloses a user selecting any desired functionalities of a product software that the user was not previously using. Incorporating this feature into Abelow would have been obvious to one of ordinary skill in the art at the time the invention was made for marketing and record keeping purposes.

### ***Conclusion***

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday-Thursday 7:00AM-5:30PM.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

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FP

March 11, 2004



FRANTZY POINVIL  
PRIMARY EXAMINER

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